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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

Rodney M. LaFollette, et al.

Docket: 7310.C

Serial No.: 09/930,539

Art Unit: 1745

Filed: August 14, 2001

Examiner: Raymond Alejandro

For: MICROSCOPIC BATTERIES FOR  
MEMS SYSTEMS

**PROVISIONAL ELECTION WITH TRAVERSE**

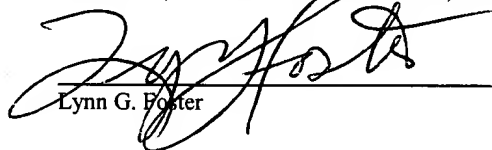
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**ELECTION**

Responsive to the Restriction and Species Requirements contained in the Office Action mailed June 4, 2004, the Applicants provisionally elect the claims of Group I, species 2, with traverse. Claims 21-40 read on the elected species.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 28, 2004.

  
Lynn G. Foster

**THE EXAMINER HAS FAILED TO MEET THE BURDEN TO SHOW SEPARATELY  
PATENTABLE (NON-OBVIOUS) CATEGORIES OF ALLEGED INVENTIONS**

**The Potential Harm of Restriction  
and Species Requirements**

A strong substantive basis must exist for either or both a Restriction Requirement and a Species Requirement. This is mandated by the MPEP, sound case law and a strong public policy. Only one U.S. Patent may issue on an invention. Otherwise, unwise, economic, oppressive, and unjustified consequences to an Applicant and to the public follow. Restriction and Species Requirements, alone or together, should never be imposed just to reduce an Examiner's workload or to reduce the time commitment and/or burden upon an Examiner.

The serious consequences to an Applicant, particularly an Applicant who is undercapitalized, as is the case here, include but are not necessarily limited to the following:

1. Loss of patent term, in later filed divisional applications, where the term is 20 years from filing.
2. Staggering increases in the collective filing fees, issue fees and maintenance fees.

**The Controlling Statute Requires  
Independent and Distinct Inventions  
for a Proper Restriction**

35 U S C § 121 states:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.  
(Emphasized.)

Thus, by statute, independent and distinct inventions are required to support a restriction requirement. One may not substitute "or" for "and" because such would radically change the meaning of the statute.

Any effort of the United States Patent and Trademark Office (USPTO) to interpret the statute as requiring independent or distinct inventions (e.g. at MPEP § 803) undertakes to rewrite the statute thereby radically changing the meaning of the statute, authority for which is not vested in the USPTO.

**The Examiners Have Failed to Meet Their Prime facie Burden**

Even assuming arguendo that the USPTO has authority to treat the § 121 statutory requirement of “independent and distinct,” as if the statute read “independent” or “distinct”, the USPTO here has woefully failed to meet its prime facie burden of showing distinct and separably patentably nonobvious inventions for Restriction and Species Election Purposes.

In respect to issues of ex parte patentability, including allegedly separately patentable inventions in a single Patent Application which are subjected to a Restriction and/or a Species Requirement, a prime facie burden rests squarely on the United States Patent and Trademark Office USPTO until fully satisfied. Only after the prime facie burden is fully satisfied by the Examiner, does the burden shift to the Applicant.

The prime facie case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ 2d 1655, 1657 n.3 (Fed. Cir.1990). The term “*prime facie case*” refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden . . . of presenting a *prime facie* case . . . . If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

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If . . . the initial stage does not product a *prime facie* case . . . , then without more the applicant is entitled [to prevail] . . . . See *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985); *In re Rinehard*, *supra*.

The burden upon the USPTO to justify a Restriction Requirement is three-fold, i.e. distinct, independent and non obvious grouping. The Examiner fails to treat and is entirely silent in respect to his burden to show separate, non-obvious inventions, each category in respect to the other

categories. The USPTO must show, not merely nakedly assert, the variously grouped claims comprise non obvious inventions. The Examiner is courteously requested to identify where in the above-mentioned Office Action he presented evidence that each restricted and species category is separately patentable (namely, nonobvious) in respect to all other categories so that separate patents issued later at different times do not violate the rules against (a) double patenting and (b) issuing more than one Patent on one invention.

While the convenience or burden of examination is a concern of the USPTO, it does not come into play unless the inventions are shown to be distinct and separately patentable (nonobvious) over each other.

MPEP § 803.01 Clearly Proclaims the Controlling Public Policy:

IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION. (Emphasis in original.)

MPEP § 802.01 defines distinct as follows:

The term distinct means that two or more subjects as disclosed are related, for example, as combination and part (subcombination ) thereof, process and apparatus for its practice, process and product made, etc. but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER . . . . (Emphasis in original.)

Restated, MPEP § 802.01, at 800-3, mandates that the restricted groupings of claims must be “PATENTABLE (novel and unobvious) OVER EACH OTHER.” (Emphasis in original.) However, the issue of patentability (nonobvious) between the groupings of claims was not addressed at all in the Office Action of June 4, 2004, contrary to Chapter 800 of the MPEP. For this reason also, the Examiner failed to meet his prime facie burden.

As to the species requirement, note the heading of MEPE § 806.04(h), i.e., “Species Must Be Patentably Distinct [nonobvious] From Each Other and From Genus.” Furthermore, MPEP § 808.01 (a) clearly states:

**Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other. (Emphasis in original.)**

No allegation of nonobviousness of each Category of Claims in respect to the other Categories was made and no proof or evidence was submitted on behalf of the USPTO. The USPTO’s burden to show nonobviousness can not be met with silence.

Thus, under In re Oeticker, supra, the Examiner failed to meet his prime facie burden. Accordingly, the burden of going forward with evidence and argument has never shifted to the Applicants.

Furthermore, MPEP § 808.02 states:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). (Emphasized.)

Again, there was no showing by the USPTO that the clearly related Groupings are patentably distinct (nonobvious).

### **Conclusion**

The Restriction and Species Requirement, in the absence of clear three-pronged proof of distinct, and nonobvious inventions and species, run counter to the policy against double patenting.

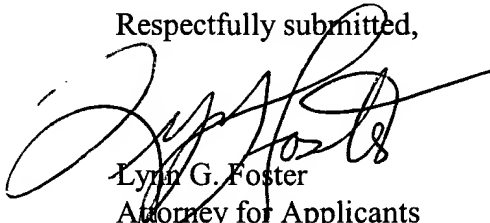
More specifically, MPEP § 804.01 in pertinent part states:

35 USC 121, third sentence, provides that where the Office requires restriction, the patent of either parent or any divisional application thereof conforming to the requirement cannot be used as a reference against the other. This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same inventions in different

language and which, if acquiesced in, might result in the issuance of several patents fo the same invention. (Emphasized.)

The USPTO has failed to make out a prime facie case that several inventions are present in the above-identified application which are nonobvious each in respect to the others. For this reason, among others, the Examiner should vacate the erroneous Restrictions and Species Requirements and act on all claims.

Respectfully submitted,



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